REMARKS

The present application was filed on December 18, 2001 with claims 1-23. In a response dated March 3, 2005, Applicants amended independent claims 1, 9, 16 and 23 to further clarify the subject matter of the invention.

In the outstanding Office Action, the Examiner: (i) rejected claims 1, 9, 16 and 23 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; (ii) rejected claims 1, 2, 4-6, 9, 12, 13, 16-18 and 20-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,256,620 to Jahawar et al. (hereinafter "Jahawar") in view of U.S. Patent No. 6,604,141 to Ventura et al. (hereinafter "Ventura") in view of U.S. Patent No. 6,349,290 to Horowitz et al. (hereinafter "Horowitz") in further view of U.S. Patent No. 6,115,462 to Servi et al. (hereinafter "Servi"); and (iii) rejected claims 7, 8, 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over Jahawar in view of Ventura in view of Horowitz in view of Servi in further view of Newton's Telecom Dictionary, 16th Edition (hereinafter "Newton").

In this response, Applicants traverse the §112, first paragraph, rejection and the various §103(a) rejections for at least the following reasons.

Regarding the §112, first paragraph, rejection of claims 1, 9, 16 and 23, Applicants respectfully point out that, in their previous response, they indicated illustrative parts of the present specification that supported the claim language added to the independent claims in that response. Namely, Applicants cited, by way of example only, canceled claim 19; page 6, line 21, through page 7, line 14; and page 11, lines 18-26, in support of the added claim language.

The present Office Action contends that the limitation: "an individual monitoring one or more computed decision values, and the individual adjusting the decision policy, when necessary or desired, so as to improve business-related performance, wherein the individual is able to adjust the decision policy without a need for programming expertise," is not supported by the present specification.

Again, Applicants respectfully points to page 6, line 21, through page 7, line 14; and page 11, lines 18-26, for illustrative support. It is stated therein that a decision support language of the invention "can be 'owned' or controlled by business analysts and managers, without relying on programmers that translate the decision specifications into a highly technical format." It is further stated therein that the invention involves reporting and "tuning" for business performance, i.e., the continued examination by a business analyst/manager 16 of the decisions made for the web

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storefront, with the ultimate goal of making improvements on the underlying decision policies . . . aspects of the Vortex language make it possible to quickly modify a Vortex program in order to achieve a desired effect . . . [t]hus, as indicated in FIG. 1, the business analyst/manager 16 monitors the decisions being made by the decision engine 20 and, if necessary or desired, adjusts decision flows for improved business performance."

Applicants assert that, based at least on the illustrative passages from the present specification reproduced above, there is more than sufficient support for the amended language.

Accordingly, it is respectfully requested that the §112, first paragraph, rejection be withdrawn.

Regarding the §103(a) rejections, the various combinations of Jahawar, Ventura, Newton and Horowitz, and now including newly cited Servi, fail to teach or suggest the step of an individual monitoring one or more computed decision values, and the individual adjusting the decision policy, when necessary or desired, so as to improve business-related performance, wherein the individual is able to adjust the decision policy without a need for programming expertise, as in the claimed invention. In addition, despite an assertion to the contrary in the Office Action, Horowitz (and thus any combinations including Horowitz) does not teach or suggest that the computed decision value is based on one or more attributes comprising at least one of: (i) an attribute representative of a business value associated with the user or the one or more applications; (ii) an attribute representative of a frustration level attributable to the user with respect to the one or more interactions; (iii) an attribute representative of an estimated profit opportunity associated with the user; and (iv) an attribute representative of availability of resources capable of taking the action, as in the claimed invention.

In particular, the present Office Action at page 6 cites steps from FIG. 26 of Horowitz, but it is not clear how anything described in FIG. 26 relates to a "business value" and how that "business value" is used to compute the "decision value," as per the claimed invention.

Further, the present Office Action supports the rejection of the limitation reciting "an individual monitoring one or more computed decision values, and the individual adjusting the decision policy, when necessary or desired, so as to improve business-related performance, wherein the individual is able to adjust the decision policy without a need for programming expertise" by merely citing column 1, lines 28-41 of Servi, without any explanation.

First, neither that part of Servi, nor any part of Servi, disclose such a feature. At column 1, lines 28-41, Servi states:

> A routing parameter is a variable used to select a particular communication path over which a telephone call travels. A network manager sets the probabilistic routing parameter, which is one of many routing parameters, based upon many pieces of information relating to communication path traffic and transmission costs. As the information regarding traffic and costs becomes available to the network manager, the network manager sets the probabilistic routing parameters to increases overall system efficiency. However, the information available to the network manager exceeds the network manager's ability to process the information. It is, therefore, desirable to automatically determine routing probabilities that can then be modified either automatically by a processor or manually by the network manager to improve the routing of telephone calls.

It is clear that Servi does not teach or suggest that a network manager monitors computed decision values and adjusts a decision policy, when necessary or desired, so as to improve business-related performance, wherein the individual is able to adjust the decision policy without a need for programming expertise, as in the claimed invention.

Furthermore, Applicants assert that any combination including Servi is improper for at least the following reasons.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action, the Examiner provides no statement to prove motivation to combine Servi with the other references. That is, the Office Action does not adequately address the factual question of motivation, as required by the Federal Circuit, since the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is also respectfully asserted that the claims which depend from independent claims 1, 9 and 16 contain patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-9, 12-18 and 20-23 are in condition for allowance, and respectfully request withdrawal of the §112, first paragraph, rejection and the various §103(a) rejections.

Respectfully submitted,

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